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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kuriacose Joseph

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SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV

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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

01/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/672,523	Applicant(s) JOSEPH ET AL.	
	Examiner Yogesh C. Garg	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/29/08&8/6/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,11,13-24,27,33,38,39,41-43,45-55,57,63,260 and 262 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,11,13-24,27,33,38,39,41-43,45-55,57,63,260 and 262 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/30/07&5/19/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendments filed on 5/29/08 and 8/6/2007 are entered. Claims 1-9, 12, 25-26, 28-32, 34-37, 40, 44, 56, 58-62, 64-259, 261 and 263-357 are cancelled. Claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260, and 262 are pending. Substitute declaration filed on 5/29/2008 is entered.

Substitute Oath/Declaration

2. Substitute declaration filed on 5/29/2008 is entered but found defective.
Claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260, and 262 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Substitute declaration is set forth in the discussion below in this Office action.

The Substitute reissue declaration filed 5/29/2008 with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a) (1) and MPEP § 1414.

The filed Substitute declaration does not identify the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). All that is needed for the

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oath/declaration statement as to error is the identification of "at least one error" relied upon. In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. The filed declaration does not do this. Instead it merely states that the original claims did not cover certain embodiments/language being presented by new claim 10. **This statement of error is not sufficient because it does not identify a single word, phrase, or expression in the specification or in an original claim (s) 1-9, and how it renders the original patent wholly or partly inoperative or invalid.** The statement filed is no better than saying in the reissue declaration that this "application is being filed to correct errors in the patent which may be noted from the change made by adding new claim 10", see MPEP 1414, II, C.

Claim Rejections - 35 USC § 251

3. Claims **10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260, and 262** are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The "recapture rule," prevents a patentee from regaining, through a reissue patent, subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

Clement discusses a three-step test for analyzing recapture:

Step 1 involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims.

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Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter.

Step 3 is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim.

Substep (3): if the reissue claim is broader in some aspects, but narrower in others, then:

(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

(b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

The Federal Circuit in *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d at 1350, 75 USPQ2d 1545 (Fed. Cir. 2005) further refined Substep (3) (a) of *Clement* to define "broader in an aspect germane to a prior art rejection" to mean broader with respect to a specific limitation

- (1) added to overcome prior art in prosecution of the application which matured into the patent sought to be reissued and
- (2) eliminated in the reissue application claims.

"Surrendered subject matter" is defined in connection with prosecution history estoppel in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-34, 122 S. Ct. 1831, 1838, 62 USPQ2d 1705, 1710-11 (2002). A patentee's decision to narrow his claims through amendment "may be presumed to be a general disclaimer of the territory between the original claim and the amended claim." *Exhibit Supply*, 315 U.S., at 136-137, 62 S. Ct. 513. "...in determining whether 'surrender' of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent." *Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006).

A further opinion, *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003), issued by the Board of Appeals and Interferences as a precedential opinion, is also part of the recapture precedent applicable to proceedings before the United States Patent & Trademark Office (USPTO). *Eggert* was entered on May 29, 2003, prior to the Federal Circuit's *North American Container* decision. In *Eggert* the majority held that the surrendered subject matter was the rejected claim **only** rather than the amended portion of the issued claim.

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A published precedential opinion of the Board is binding unless the views expressed in an opinion in support of the decision, among a number of things, are inconsistent with a decision of the Federal Circuit. In this case, the majority view in *Eggert* is believed to be inconsistent with the subsequent Federal Circuit decision in *North American Container* with respect to the principles governing application of Substep (3)(a) of *Clement*. See: *Ex parte Franklin C. Bradshaw and Thomas L. Soderman*, (Appeal 2006-2744 Bd. Pat. App. & Int. July 19, 2007) (available in Application 09/664,794 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd062744.pdf>); *Ex parte Raanan Liebermann*, (Appeal 2007-0012 Bd. Pat. App. & Int. May 2007) (available in Application 09/603,247 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd070012.pdf>); *Ex parte Willibald Kraus* (Appeal 2005-0841 Bd. Pat. App. & Int. April 2005) (available in Application 08/230,083 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd050841.pdf>)

As set forth in the above BPAI decisions, based on *North American Container* and other court decisions, surrendered subject matter is considered the subject matter of an application claim which was amended or canceled and, on a limitation-by-limitation basis, the territory falling between the scopes of

- (a) the application claim which was canceled or amended and
- (b) the patent claim which was ultimately issued.

Accordingly, the "surrendered subject matter" that may not be recaptured through reissue should *be presumed* to include subject matter broader than the patent claims in a manner directly related to

- (1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and
- (2) limitations argued to overcome a patentability rejection without amendment of a claim.

However, when reissue claims are narrower than the patent claims with respect to features other than the surrender generating feature, then the reissue claims may be materially narrowed relative to the claims prosecuted and issued in the patent, thereby avoiding the recapture rule.

As explained in *Hester Industries, Inc. v Stein, Inc.*, 142 F.3d 1472,1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998), the recapture rule is avoided when two conditions are satisfied. First, an aspect of the invention must have been overlooked (e.g., not claimed) during patent prosecution. Second, the reissue claim must have been materially narrowed with respect to this overlooked aspect of the invention.

In summary, the recapture rule is avoided if the reissue claim was

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materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention:

- (1) which had not been claimed and thus were overlooked during prosecution of the original patent application; and
- (2) which patentably distinguish over the prior art.

In the instant case, the reissue claims satisfy the “recapture rule” preventing a patentee from receiving a reissue patent as per both *Clement three steps test* and *Hester Industries, Inc, v Stein, Inc., 142 F.3d 1472,1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998)* as analyzed below:

A: Analysis per *Clement three-step test*:

New claims 10-11, 13-24, 27, 33, 38-39, 41-43, 45-55, 57, 63, 260, and 262 are broader than the patented claims 1-9 because they do not include limitations recited in the patented claims 1-9. There was a surrender of subject matter in the original application prosecution and the broadening of the reissue claims is in the area of the surrendered subject matter. The omitted/broadened limitations in the reissue claims are directed to limitations relied upon by the applicant in the original application to make the claims allowable over prior art (At a minimum, the claims require at least one of the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,908 application: *a source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and*

wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted OR a client computer, which includes a packet selector connected to said source for selecting and directing packets containing said auxiliary data representing said video program to a video signal processor and selecting and directing packets containing said associated distributed computing application to a further processor OR further processor including means to assemble said distributed computing application and execute said distributed computing application to form an interactive video program in which execution of said distributed computing application alters said video program OR a source of a time division multiplexed packet signal including a plurality of distributed computing applications, each distributed computing application being repetitively transmitted independent of receiving client computer apparatus, and each of said distributed computing applications being in a form of a series of packets OR a first one of packets of a respective series containing data representing an executable code module and including identification information indicating that the first one of packets of said series contains data representing said executable code module OR the client computer extracts said directory module from the data stream and using data contained in the directory module extracts packets associated with said distributed computing application and builds said distributed computing application and executes said distributed computing application OR read/write memory, coupled to the system bus; a data stream input/output adapter, coupled between the data stream receiver and the system bus, for receiving the extracted distributed computing application representative data from the data stream receiver, and storing it in the read/write memory, and having a control output terminal coupled to the selection control input terminal of the data stream selector, for producing the selection control signal; and a processor, coupled to the system bus, for controlling the data stream input/output device to generate a

selection control signal selecting a specified one of the plurality of data streams, and for assembling and executing the distributed computing application stored in the read/write memory.). The filed re-issue claims are broader than the original patent claims by not including the surrender-generating limitations (as described above) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

B: Analysis as per *Hester Industries, Inc. v Stein, Inc.*: In order to satisfy the two conditions, the subject matter that materially narrows the reissue claims should be the overlooked aspect of the original invention claimed in the patent. In the instant case, the reissue claims do not include any subject matter of the patented claims (independent patented claims 1, 6, 9, 10) but instead the subject matter that materially narrows the reissue claims is directed to a distinct

and different invention and it is not the overlooked aspect of the original invention.

4. Best Prior art discussion:

(i) US Patent 5,621,456, Florin et al (hereinafter Florin) discloses a method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method comprising (i.e. home shopping interface)(see Fig. 1, and col. 23, line 59 - col. 24, line 7) receiving an order request at a client system, automatically determining an item identity for an item to which the order request pertains, automatically retrieving personal information previously stored, the retrieved personal information pertaining to a user associated with the client system and causing an order to be placed, (see col.24, lines 7-58 and Figs. 45-50 discloses receiving an order request via icon 409 at a client system, automatically determining an item identity for an item , such as “ Lucks Mini Espresso” to with the order request pertains and causing an order to be placed[see figs 49-50] including the item identity and the retrieved personal information relating to the PIN entered in Fig.49. However, Florin, alone or combined, does not disclose or render obvious receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data, responding to the single action by: (a) retrieving personal information of the user from a permanent memory in the client, (b) combining the item data previously received via the data stream from the server with the personal

information of the user previously stored in the permanent memory in the client to generate an order for the item, and (c) transmitting the order for the item from the client.

(ii) Schlafly (U.S. 4,734,858) discloses a pocket size data terminal that is used by the consumer to initially select and store data representative of the orders. (Schlafly, Abstract.) When later connected to a phone line the terminal can be commanded to automatically dial and transmit the stored data in a short burst over a telephone link to a local processing center for processing including customer verification, data format and credit verification, order placement and supplier contact. Each terminal is assigned an internal identification number and a specific local processing center which the terminal can automatically access. (Schlafly, 1: 44-57.) As explained above, the consumer must initially select and store data representative of the orders. Specifically, Schlafly discloses an ORDER key to store the order data collected from the customer in the send memory. (Schlafly, 9: 12-21.) In order to actually send the order, Schlafly utilizes a send instruction implemented by the ENTER key. (Schlafly, 10: 3-10.) While Schlafly discloses sending the order data to an appropriate destination by actuating the ENTER key, it takes more than a single action on the part of a user to select an item, enter the order-related information, such as the quantity and the supplier (Schlafly, 7: 26-34), save the order data and, finally, transmit the order. Schlafly does not teach or render obvious the steps of "receiving a control event associated with a single action effectuated by the user in response to the presenting of the at least a portion of the item data" and "responding to the single action by ... retrieving personal information of the

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user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client.", Because, Schlafly, whether considered separately or in combination with Florin, does not disclose or suggest responding to a single action by a user by performing operations that together make it possible to place an order (specifically, a combination of "retrieving personal information of the user from a permanent memory in the client, combining the item data previously received via the data stream from the server with the personal information of the user previously stored in the permanent memory in the client to generate an order for the item, and transmitting the order for the item from the client," as recited in claim 10).

Response to Arguments

5 In view of the current amendments made to all the three independent claims 10, 38 and 260, rejection of claims USC 112, first and second paragraphs in the Office action mailed on 5/03/2007 are withdrawn.

In view of the current amendments made to all the three independent claims 10, 38 and 260, rejection of claims under USC 251 as being based upon new matter are withdrawn.

Applicant's arguments see Remarks, pages 7-12, filed 8/6/2007, with respect to

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rejection of currently amended independent claims 10, 38 and 260 under 35 USC 103 (a) as being unpatentable over Florin et al. (US Patent 5,621,456) in view of Schlafly (US Patent 4,734,858) have been fully considered and are persuasive. The rejection of currently amended independent claims 10, 38 and 260 under 35 USC 103 (a) have been withdrawn.

The applicant's arguments filed 8/4/2006 have been considered fully and are also not persuasive. The applicant argues (see page 2) that: it is not possible to surrender subject matter that was never prosecuted in the '034 patent" because the filed reissue claims are distinct from the patented claims. The examiner respectfully disagrees because as analyzed above under *Clement three-steps test* and *Hester Industries, Inc, v Stein, Inc.*: the filed reissue claims do not satisfy the "recapture rule" preventing a patentee from receiving a reissue patent. The applicant further argues that *"In this case, the Applicants mistakenly failed to claim subject matter pertaining to a disclosed embodiment. MPEP 1412.01 states, "...the mere failure to claim a disclosed embodiment in the original patent (absent an explicit statement in the original patent specification of unsuitability of the embodiment) would not be grounds for prohibiting a claim to that embodiment in the reissue."* The examiner respectfully disagrees as analyzed above under the Heading "Oath/Declaration" because the statement of error is not sufficient because it does not identify a single word, phrase, or expression in the specification or in an original claim (s) 1-9, and how it renders the original patent wholly or partly inoperative or invalid. The statement filed is no better than saying in the reissue declaration that this "application is being filed to correct errors

in the patent which may be noted from the change made by adding new claim 10", see MPEP 1414, II, C.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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